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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,638	09/12/2003	Katsuhisa Yamazaki	02910.000079.	7561

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/660,638

Applicant(s)

YAMAZAKI ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attachment, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1 and 3-17.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attachment, paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/660,638

Examiner

Janis L. Dote

Applicant(s)

YAMAZAKI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 11 August 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
 - ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
 - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
 - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
 - ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: see the attachment, paragraph 2.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

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1. The proposed amendment to the specification filed on Aug. 11, 2005, deleting paragraphs [0055C] and [0055D] in the substitute specification filed on Jan. 10, 2005, raises new issues because the deletion of the paragraphs removes the definitions of the terms "rate of liberation 'a'" and "rate of liberation 'b'" recited in instant claim 1. Said deletion of the paragraphs would reinstate the rejection of claim 1 and claims dependent thereon under 35 U.S.C. 112, second paragraph, set forth in the first office action mailed on Sep. 8, 2004, paragraph 6. That rejection was withdrawn in response to the addition of the subject matter disclosed in paragraphs [0055C] and [0055D].

2. Notice of NON-COMPLIANT AMENDMENT (37 CFR 1.121)

Item E: Claim 4, labeled as "previously presented." is not in compliance with 37 CFR 1.121 because the previously inserted terminal period has been deleted without the proper markings to show its deletion. See the entered amended claim 4 filed on Jan. 10, 2005. Furthermore, the claim should have been labeled as "currently amended."

37 CFR 1.121 reads: "[W]hen claim text with markings is required. All claims being currently amended . . . shall . . . be submitted with markings to indicate changes that have been made relative to the immediate prior version of the claims. The

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text of any added subject must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets [i.e., [[]]] placed before and after the deleted characters may be used to show deletion of five or fewer consecutive letters" (emphasis added).

3. The examiner's refusal to enter the proposed amendment filed on Aug. 11, 2005, renders applicants' arguments regarding said amendment moot.

Furthermore, applicants' allegations that the definitions of the rate of liberation "a" and the rate of liberation "b," as stated at pages 10 and 11 of applicants' response filed on Aug. 11, 2005, are inherently present in the originally filed specification and that the definitions are well-known to a person having ordinary skill in the art are merely attorney argument. There is no objective evidence in the present record to support applicants' allegations. Applicants have not provided any objective evidence showing that the rates of liberations recited in instant claim 1 are indeed the definitions alleged by applicants at pages 10 and 11 of applicants' response, e.g., in the form of a standard textbook or a Rule 132 declaration from an expert in the art showing that the definitions of the rates of liberation recited in instant claim 1 are indeed those alleged by applications. As discussed in the final office action mailed on Apr. 11, 2005, the

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paragraph bridging pages 6 and 7, the originally filed specification does not provide any definition of the rate of liberation "a" nor of the rate of liberation "b" recited in the instant claims. Furthermore, the examiner's interpretations of the rate of liberation "a" and the rate of liberation "b" set forth in the first office action mailed Sep. 9, 2004, paragraph 7, are used to provide a provisional interpretation of the claims so that the patentability of the claims could be tested over the prior art. This was done in an attempt to expedite prosecution. The examiner's interpretations of the rates of liberation do not provide antecedent basis in the specification as filed for applicants' alleged definitions. Nor do the examiner's interpretations provide evidence that applicants' alleged definitions are the standard and acceptable definitions in the art. Moreover, there is no objective evidence in the present record to show that the definitions of the rates of liberation in US Published Patent Application 2001/0028988 A1 (Magome) are the standard and acceptable definitions in the art. Nor is there any objective evidence in the present record showing that the rates of liberation recited in the instant claims have the same definitions as disclosed in Magome.